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10/749,820	12/31/2003	Michael D. Kotzin	CS22914RA	9362
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			ART UNIT	PAPER NUMBER
			2139	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/749,820	Applicant(s) KOTZIN ET AL.	
	Examiner CANH LE	Art Unit 2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-11, 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the application filed on 02/21/2008.

Claims 3 and 12 have been cancelled.

Claims 1, 8, and 14 have been amended.

Claims 1-2, 4-11, 13-17 have been examined and are pending.

Response to Arguments

Applicant's arguments filed 02/21/2008 have been fully considered but they are not persuasive.

With regard to claims 1-2, 4-11, and 13 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 5,668,875 (Brown) in view of US 2003/0233546 (Blom) on pg. 6-8, the Applicant argues that Malinen, Brown, or Blom does not show or suggest obtaining a challenge response pair subsequent to issuing a random challenge and receiving the response.

The Examiner respectfully disagrees,

Malinen teaches obtaining one of the challenge response pairs associated with the electronic device *[par. [0083], lines 7-12; par. [0011], lines 1-3; "an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific"]*;

Malinen does not teach a method, wherein issuing plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Brown teaches a method, wherein issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic [col. 4, line 66 to col.5 line 3; col. 11, lines 14-17; a *RAND generator 136 is used for generating the challenges in communication with the subscribe unit 110. Once the responses are received at VLR, the MSI, location, service request and RAND/RESP_v pairs are forward to home system and home location register or other authenticating center for the user identity unit*"].

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Brown because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

The Applicant amended the limitation in claim 1 as the following:

“obtaining one of the challenge response pairs associated with the electronic device subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device”. This is inherent that a device can not obtain one of the challenge response pairs without getting an issuance the plurality of random challenges to the device. Malinen teaches the

limitation of “obtaining one of the challenge response pairs associated with the electronic device”, while Brown teaches the limitation “issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device”. Therefore, the combination of Malinen and Brown teach the limitation as said set forth in claim 1. The new limitation added in claim 1 (i.e. “subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device) is inherent and does not change the scope of the limitation of the previous office action rejection filed on 08/22/2007. The same argument applies for claim 8 and 14.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It is proper to combine teaching of Malinen and Brown and further in view of Blom because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [*Blom*, par. [001], lines 3-7].

With regard to claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 5,668,875 (Brown) in view WO 00/02406 (Ekberg) and

further in view of US 2003/0233546 (Blom) on pg. 8, the Applicant argues Ekberg also does not show or suggest “obtaining from an electronic device a plurality of challenge response pairs subsequent to issuance of a plurality of random challenges to the electronic device and receiving a plurality of response from electronic device” as recited by independent claim 14.

The Examiner respectfully disagrees, Please see the same argument which Malinen, Brown, and Blom teach the above limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is proper to combine teaching of Malinen, Brown, Ekberg, and further in view of Blom because Blom discloses the limitation which Malinen, Brown and Ekberg do not disclose such as storing the challenge response pairs [*abstract, lines 13-17; pg. 14, lines 27-37; pg. 15, lines 1-9*] because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [*Blom, par. [001], lines 3-7*].

*With regard to claims 1-2, 4-11, and 13 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 2005/0113067 (Marcovici)*⁷ *in view of US 2003/0233546 (Blom) on pg. 9-11*, the Applicant argues that Marcovici does not or suggest “obtaining one of the challenge response pairs associated with the electronic device subsequently to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device” recited by independent claims 1 and 8, as amended.

The Examiner respectfully disagrees,

Malinen *teaches* obtaining one of the challenge response pairs associated with the electronic device [*par. [0083], lines 7-12; par. [0011], lines 1-3; “an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific”*];

Malinen does not teach a method, wherein issuing plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Marcovici teaches a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device [*par. [0036], lines 12-16; “The act of authenticating may include*

transmitting one or more random challenges and receiving one or more responses associated with the random challenges, where the response(s) may be determined based on applying the WKEY to the random challenge(s)”; par. [0041]; lines 1-10; par. 0041; lines 1-2];

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Marcovici because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

The Applicant amended the limitation in claim 1 as the following:

“obtaining one of the challenge response pairs associated with the electronic device **subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device**”. This is inherent that a device can not obtain one of the challenge response pairs without get an issuance the plurality of random challenges to the device. Malinen teaches the limitation of “obtaining one of the challenge response pairs associated with the electronic device”, while Marcovici teaches the limitation “issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device”. Therefore, the combination of Malinen and Marcovici teach the imitation as said set forth in claim 1. The new limitation added in claim 1 (i.e. “subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device) is inherent and does not

change the scope of the limitation of the previous office action rejection filed on 08/22/2007. The same argument applies for claim 8 and 14.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is proper to combine teaching of Malinen and Marcovici and further in view of Blom because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [*Blom, par. [001], lines 3-7*].

With regard to claims 14-17 under 35 U.S.C. 103(a) as being unpatentable over 2003/0028763 (Malinen) and US 2005/0113067 (Marcovici) in view of WO 00/02406 (Ekberg) and further in view of US 2003/0233546 (Blom) on pg. 11, the Applicant argues that Malinen, Marcovici, Ekberg, and Blom do show or suggest “obtaining from a n electronic device a plurality of challenge response pairs subsequent to issuance of a plurality of random challenges to electronic device and receiving a plurality of responses from the electronic device” as recited by the independent claim 14.

The Examiner respectfully disagrees, Please see the same argument which Malinen, Brown, and Blom teach the above limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It is proper to combine teaching of Malinen , Marcovici , Blom, and further in view of Ekberg because Ekberg discloses the limitation which Malinen, Marcovici and Blom do not disclose such as storing the challenge response pairs [*abstract, lines 13-17; pg. 14, lines 27-37; pg. 15, lines 1-9*] because it allows a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [*Blom, par. [001], lines 3-7*].

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative should not be construed as indicating Examiner's agreement therewith.

Claim Objections

Claim 1 is objected to because of the following informalities:

Claim 1 recites the limitation as the following:

(a) issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device;

(b) obtaining one of the challenge response pairs associated with the electronic device **subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device;**

The phrase “ **subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of responses from the electronic device**” is redundant and does not change the scope of the limitation. An electronic device can not obtain one of the challenge response pairs without get an issuance the plurality of random challenges to the device. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Malinen et al.** (Publication Number: US 2003/0028763 A1) and **Brown et al.** (US Patent 5,668,875) in view of **Blom** (US 2003/0233546 A1).

Claim 1

Malinen teaches a method of authenticating an electronic device, the electronic device having device specific identifying data stored therein, the method comprising:

(b) obtaining one of the challenge response pairs associated with the electronic device [*par. [0083], lines 7-12; par. [0011], lines 1-3; “an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific”*] subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic device [*Please see Response to Arguments as described above*].

communicating a challenge portion of the challenge response pair to the electronic device [*par. [0011], lines 1-5; the challenge is sent to the client*].

receiving from the electronic device a response to the challenge portion, wherein the response being based upon the device specific identifying information [*par. [0011], lines 5-6; a client generates a response that is sent back to the authorizer*].

comparing the response to a response portion of the challenge response pair [*par. [0011], lines 6-7; an authorizer compares the challenge to the response*]; and

authenticating the user if the response matches *[par. [0011], lines 8-9; If the response is correct, the authorizer provides a service to the client]*.

Malinen does not teach a method, wherein issuing of plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Brown teaches a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device *[col. 4, line 66 to col.5 line 3; col. 11, lines 14-17; a RAND generator 136 is used for generating the challenges in communication with the subscribe unit 110. Once the responses are received at VLR, the MSI, location, service request and RAND/RESP_v pairs are forward to home system and home location register or other authenticating center for the user identity unit"]*;

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Brown because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol *[Blom, par. [001], lines 3-7]*.

Claim 2

Malinen also teaches the method of claim 1, wherein the step of obtaining one of the challenge response pairs comprises obtaining from a database store of challenge response pairs the challenge response pair *[par. [0083], lines 7-12; an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. The local database can be used to store more than one challenge response pair]*.

Claim 4

Blom further teaches the method of claim 1, wherein the step of obtaining a challenge response pair comprises obtaining a challenge response pair from a challenge response pair broker *[par. [0059], lines 11-14; a broker acting as a general authentication center or service provider]*.

Claim 5

Malinen further teaches the method of claim 1, wherein the device specific identifying data comprises data stored on a subscriber identity module (SIM) card associated with the electronic device, or computed by the SIM card upon demand *[par. [0074], lines 11-13. A SIM card provides a session key for the mobile node, and a response is sent back to an authorizer]*.

Claim 6

Malinen further teaches the method of claim 1, comprising the step of discarding the challenge response pair after use [*par. [0194]; a router advertisement contains a “challenge”, which is essentially a random number used as a nonce*].

Claim 7

Malinen further teaches the method of claim 1, wherein the step of obtaining a challenge response pair comprises obtaining via a secure communication interface the challenge response pair [*par. [0073]; par. [0074]; a client can use its own generated instance of the session key for secure communication with access provider. It is included to obtain a challenge response pair*].

Claim 8

Claim 8 is essentially the same as claim 1 except that it sets forth the claimed invention as a system further comprising a memory for storing the challenge response pair [*see Malinen, par. [0083], lines 7-12; a memory is equivalent to a database*] rather a method and rejected under the same reasons as applied above.

Claim 9

Malinen further teaches the system of claim 8, wherein the device specific identifying data comprises subscribed identity module (SIM) card data from a SIM card within the electronic device [*par. [0074], lines 10-13*].

Claim 10

Malinen further teaches the system of claim 9, wherein the user comprises a service provider having a need to authenticate the electronic device *[par. [0074], lines 10-13]*.

Claim 11

Malinen further the system of claim 10, wherein the agent for interrogating and the agent for providing are associated with the service provider *[par. [007], lines 2-4]*.

Claim 13

Blom further teaches the system of claim 8, wherein the agent for providing the challenge response pair comprises a challenge response pair broker *[par. [0059], lines 11-14; a broker acting as a general authentication center or service provider]*.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Malinen et al.** (Publication Number: US 2003/0028763 A1) and **Brown et al.** (US Patent 5,668,875) in view of **Ekberg** (International Publication Number: WO 00/02406) and further in view of **Blom** (US 2003/0233546 A1).

Claim 14

Malinen teaches a method of providing an authentication service comprising the steps of:

providing responsive to a request for an authentication service a challenge response pair to a service provider for authenticating the electronic device by communicating a challenge portion of the challenge response pair to the electronic device *[par. [0011], lines 1-5; the challenge is sent to the client, receiving from the electronic device a response to the challenge portion [par. [0011], lines 5-6; a client generates a response that is sent back to the authorizer]*, wherein the response being based upon the device specific identifying information, comparing the response from the electronic device to a response portion of the challenge response pair *[par. [0011], lines 6-7; an authorizer compares the challenge to the response]; and authenticating the user if the response matches [par. [0011], lines 8-9; If the response is correct, the authorizer provides a service to the client]; and*

authentication the user if the response matches *[par. [0011], lines 8-9; If the response is correct, the authorizer compares the challenge to the response]*.

obtaining from an electronic device a plurality of challenge response pairs *[par. [0083], lines 7-12; par. [0011], lines 1-3; “an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific”]* subsequent to issuance of a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device *[Please see Response to Arguments as described above]*.

wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon the challenge and device specific identifying data associated with the electronic device *[par. [0083], lines 7-12; par. [0011], lines 1-3]*.

Malinen does not teach a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Brown teaches a method of issuing of a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon the challenge and device specific identifying data associated with the electronic device *[col. 4, line 66 to col.5 line 3; col. 11, lines 14-17; a RAND generator 136 is used for generating the challenges in communication with the subscribe unit 110. Once the responses are received at VLR, the MSI, location, service request and RAND/RESP_v pairs are forward to home system and home location register or other authenticating center for the user identity unit"]*;

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Brown because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol *[Blom, par. [001], lines 3-7]*.

Malinen and Brown do not teach for storing the challenge response pairs.

However, Ekberg teaches a method of storing the challenge response pairs *[abstract, lines 13-17; pg. 14, lines 27-37; pg. 15 lines 1-9; a subscriber-specific information is stored in a database (DB) in advance. A subscriber's authentication is contained at least a challenge and a response];*

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to combine the method of Malinen, Ekberg, and Brown by including the motivation of Blom because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol *[Blom, par. [001], lines 3-7].*

Claim 15

Malinen further teaches the method of claim 14, wherein the step of obtaining from an electronic device a plurality of challenge response pairs comprises generating from a subscribed identify module (SIM) card a plurality of challenge response pairs and providing the SIM card to a user of the electronic device *[par. [0088], lines 2-3; a set of n SIM challenges, responses, and session keys may be used to create a key].*

Claim 16

Blom further teaches the method of claim 14, wherein the step of providing response to a request for an authentication service a challenge response pair comprises vending the challenge response pair *[par. [0024], lines 21-25; a service provider is equivalent to a vendor].*

Claim 17

Malinen further teaches the method of claim 14, wherein the step of providing response to a request for an authentication service a challenge response pair comprises securely communicating the challenge response pair to the service provider *[par. [0073]; par. [0074]; a client can use its own generated instance of the session key for secure communication with access provider. It is included to obtain a challenge response pair]*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Malinen et al.** (Publication Number: US 2003/0028763 A1) and **Marcovici et al.** (US 2005/0113067 A1) in view of **Blom** (US 2003/0233546 A1).

Claim 1

Malinen teaches a method of authenticating an electronic device, the electronic device having device specific identifying data stored therein, the method comprising:

obtaining one of the challenge response pairs associated with the electronic device *[par. [0083], lines 7-12; par. [0011], lines 1-3; “an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific”]* subsequent to issuing the plurality of random challenges to the electronic device and receiving the plurality of response from the electronic *[Please see Response to Arguments as described above];*

communicating a challenge portion of the challenge response pair to the electronic device *[par. [0011], lines 1-5; the challenge is sent to the client].*

receiving from the electronic device a response to the challenge portion, wherein the response being based upon the device specific identifying information *[par. [0011], lines 5-6; a client generates a response that is sent back to the authorizer].*

comparing the response to a response portion of the challenge response pair *[par. [0011], lines 6-7; an authorizer compares the challenge to the response];* and

authenticating the user if the response matches *[par. [0011], lines 8-9; If the response is correct, the authorizer provides a service to the client].*

Malinen does not teach a method wherein, issuing the plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Marcovici teaches a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic

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device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device [par. [0036], lines 12-16; *"The act of authenticating may include transmitting one or more random challenges and receiving one or more responses associated with the random challenges, where the response(s) may be determined based on applying the WKEY to the random challenge(s)"; par. [0041]; lines 1-10; par. 0041; lines 1-2;*

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Marcovici because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol [Blom, par. [001], lines 3-7].

Claim 2

Malinen also teaches the method of claim 1, wherein the step of obtaining one of the challenge response pairs comprises obtaining from a database store of challenge response pairs the challenge response pair [par. [0083], lines 7-12; *an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. The local database can be used to store more than one challenge response pair*].

Claim 4

Blom further teaches the method of claim 1, wherein the step of obtaining a challenge response pair comprises obtaining a challenge response pair from a challenge response pair broker *[par. [0059], lines 11-14; a broker acting as a general authentication center or service provider]*.

Claim 5

Malinen further teaches the method of claim 1, wherein the device specific identifying data comprises data stored on a subscriber identity module (SIM) card associated with the electronic device, or computed by the SIM card upon demand *[par. [0074], lines 11-13. A SIM card provides a session key for the mobile node, and a response is sent back to an authorizer]*.

Claim 6

Malinen further teaches the method of claim 1, comprising the step of discarding the challenge response pair after use *[par. [0194]; a router advertisement contains a "challenge", which is essentially a random number used as a nonce]*.

Claim 7

Malinen further teaches the method of claim 1, wherein the step of obtaining a challenge response pair comprises obtaining via a secure communication interface the challenge response pair *[par. [0073]; par. [0074]; a client can use its own generated*

instance of the session key for secure communication with access provider. It is included to obtain a challenge response pair].

Claim 8

Claim 8 is essentially the same as claim 1 except that it sets forth the claimed invention as a system further comprising a memory for storing the challenge response pair [see *Malinen, par. [0083], lines 7-12; a memory is equivalent to a database*] rather a method and rejected under the same reasons as applied above.

Claim 9

Malinen further teaches the system of claim 8, wherein the device specific identifying data comprises subscribed identity module (SIM) card data from a SIM card within the electronic device [*par. [0074], lines 10-13*].

Claim 10

Malinen further teaches the system of claim 9, wherein the user comprises a service provider having a need to authenticate the electronic device [*par. [0074], lines 10-13*].

Claim 11

Malinen further the system of claim 10, wherein the agent for interrogating and the agent for providing are associated with the service provider [*par. [007], lines 2-4*].

Claim 13

Blom further teaches the system of claim 8, wherein the agent for providing the challenge response pair comprises a challenge response pair broker *[par. [0059], lines 11-14; a broker acting as a general authentication center or service provider]*.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Malinen et al.** (Publication Number: US 2003/0028763 A1) and **Marcovici et al.** (US 2005/0113067 A1) in view of **Ekberg** (International Publication Number: WO 00/02406) and further in view of **Blom** (US 2003/0233546 A1).

Claim 14

Malinen teaches a method of providing an authentication service comprising the steps of:

providing responsive to a request for an authentication service a challenge response pair to a service provider for authenticating the electronic device by communicating a challenge portion of the challenge response pair to the electronic device *[par. [0011], lines 1-5; the challenge is sent to the client, receiving from the electronic device a response to the challenge portion [par. [0011], lines 5-6; a client generates a response that is sent back to the authorizer]*, wherein the response being based upon the device specific identifying information, comparing the response from the electronic device to a response portion of the challenge response pair *[par. [0011], lines 6-7; an authorizer compares the challenge to the response]; and authenticating the user*

if the response matches [par. [0011], lines 8-9; If the response is correct, the authorizer provides a service to the client]; and

authentication the user if the response matches *[par. [0011], lines 8-9; If the response is correct, the authorizer compares the challenge to the response]*.

obtaining from an electronic device a plurality of challenge response pairs [par. [0083], lines 7-12; par. [0011], lines 1-3; “an authentication gateway 115 maintains an authentication session and is able to query the RAND (i.e. challenge) and SRES (i.e. system response) for a received International Mobile Subscriber Identifier (IMSI) from a local authorization database. An identity associated with a client is equivalent to the device specific”] subsequent to issuance of a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device *[Please see Response to Arguments as described above]*, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon the challenge and device specific identifying data associated with the electronic device [par. [0083], lines 7-12; par. [0011], lines 1-3].

Malinen does not teach a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device.

However, Marcovici teaches a method of issuing a plurality of random challenges to the electronic device and receiving a plurality of responses from the electronic device, wherein each random challenge and corresponding response represents a challenge response pair which is unique and based upon specific identifying data of the electronic device *[par. [0036], lines 12-16; “The act of authenticating may include transmitting one*

or more random challenges and receiving one or more responses associated with the random challenges, where the response(s) may be determined based on applying the WKEY to the random challenge(s)”; par. [0041]; lines 1-10; par. 0041; lines 1-2];

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the method of Malinen by including the step of Marcovici because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol *[Blom, par. [001], lines 3-7]*.

Malinen and Marcovici do not explicitly teach for storing the challenge response pairs.

However, Ekberg teaches a method of storing the challenge response pairs *[abstract, lines 13-17; pg. 14, lines 27-37; pg. 15 lines 1-9; a subscriber-specific information is stored in a database (DB) in advance. A subscriber’s authentication is contained at least a challenge and a response];*

Thus, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to combine the method of Malinen, Ekberg, and Marcovici by including the motivation of Blom because it would allow a subscriber and its associated home system authentication protocol, and a roamed system uses a corresponding local authentication protocol *[Blom, par. [001], lines 3-7]*.

Claim 15

Malinen further teaches the method of claim 14, wherein the step of obtaining from an electronic device a plurality of challenge response pairs comprises generating from a subscribed identify module (SIM) card a plurality of challenge response pairs and providing the SIM card to a user of the electronic device *[par. [0088], lines 2-3; a set of n SIM challenges, responses, and session keys may be used to create a key]*.

Claim 16

Blom further teaches the method of claim 14, wherein the step of providing response to a request for an authentication service a challenge response pair comprises vending the challenge response pair *[par. [0024], lines 21-25; a service provider is equivalent to a vendor]*.

Claim 17

Malinen further teaches the method of claim 14, wherein the step of providing response to a request for an authentication service a challenge response pair comprises securely communicating the challenge response pair to the service provider *[par. [0073]; par. [0074]; a client can use its own generated instance of the session key for secure communication with access provider. It is included to obtain a challenge response pair]*.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Canh Le whose telephone number is 571-270-1380. The examiner can normally be reached on Monday to Friday 7:30AM to 5:00PM other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kincaid Kristine, can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Canh Le/

Examiner, Art Unit 2139

April 29, 2008

/Kristine Kincaid/

Supervisory Patent Examiner, Art Unit 2139